RECORD AND BRIEFS

No. 15-866

Supreme Court, U.S.
FILED
SEP 19 2016
OFFICE OF THE CLERK

IN THE
Supreme Court of the United States

STAR ATHLETICA,
Petitioner,

v.

VARSITY BRANDS,
Respondent.

On a Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit

BRIEF OF *AMICUS CURIAE* INTELLECTUAL PROPERTY OWNERS ASSOCIATION IN SUPPORT OF RESPONDENT

INTELLECTUAL PROPERTY OWNERS ASSOCIATION
KEVIN H. RHODES, *President*
STEVEN W. MILLER, *Chair*
Amicus Brief Committee
1051 M Street, NW, Suite 1150
Washington, DC 20005
(202) 507-4500

DAVID LEICHTMAN
Counsel of Record
SHERLI FURST
ROBINS KAPLAN LLP
601 Lexington Avenue
New York, NY 10022
(212) 980-7400
dleichtman@robinskaplan.com
sfurst@robinskaplan.com

Counsel for Amicus Curiae
Intellectual Property Owners Association

TABLE OF CONTENTS

INTEREST OF AMICUS CURIAE 1

SUMMARY OF ARGUMENT 2

ARGUMENT 4

A. Why This Case Is Important Beyond Cheerleading Uniforms 4

B. The Sixth Circuit Merely Synthesized the Law of All of the Circuits 6

C. The Sixth Circuit's Synthesis of the Different Approaches Was Correct and Lays Out the Correct Test for Determining Whether the "Useful Article" Exception to Copyrightability Applies 8

D. The Sixth Circuit Correctly Rejected Subjective Criteria Proposed by Academic Commentaries. 15

E. "Originality" Is Not Part of the "Separability" Analysis and Section 102(b) Is Not Before the Court 17

CONCLUSION 26

TABLE OF AUTHORITIES

Cases **Page(s)**

Alpi Int'l, Ltd. v. Anga Supply, LLC,
118 F. Supp. 3d 1172 (N.D. Cal. 2015) 25

Baker v. Selden,
101 U.S. 99 (1879) 20

Bleistein v. Donaldson Lithographing Co.,
188 U.S. 239 (1903) 16

Cain v. Universal Pictures
Co.,47 F. Supp. 1013, 1017 (S.D. Cal.
1942) 22, 23

Comput. Assocs., Inc. v. Altai,
982 F.2d 693 (2d Cir. 1992) 21, 22, 24

Dellar v. Samuel Goldwyn,
150 F.2d 612 (2d Cir. 1945) 24

Eichel v. Marcin,
241 F. 404 (S.D.N.Y. 1913) 24

Feist Publ'ns, Inc. v. Rural Tel. Serv.
Co., 499 U.S. 340 (1991) 25

Folkens v. Wyland,
No. 14-2197, 2016 U.S. Dist. LEXIS
47373 (E.D. Cal. Apr. 6, 2016) 25

Golan v. Holder,
132 S. Ct. 873 (2012) 19

Herbert Rosenthal Jewelry Corp. v. Kalpakian,
446 F.2d 738 (9th Cir. 1971) 23

Hoberman Designs, Inc. v. Gloworks Imps., Inc.,
No. 14-6743, 2015 U.S. Dist. LEXIS 176117 (C.D. Cal. Nov. 3, 2015) 25

Kirtsaeng v. John Wiley.
136 S. Ct. 1979 (2016) 6, 10, 17

L. Batlin & Son, Inc. v. Snyder,
536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976) 24

Mazer v. Stein,
347 U.S. 201 (1954) 19

Nichols v. Universal Pictures Corp.,
45 F.2d 119 (2d Cir. 1930) 23

Octane Fitness, LLC v. ICON Health & Fitness, Inc.,
572 U.S. ____, 134 S. Ct. 1749 (2014) 5, 10, 17

Oracle Am., Inc. v. Google, Inc.,
750 F.3d 1339 (Fed. Cir. 2014) 21

Rentmeester v. Nike, Inc.,
No. 15-113, 2015 U.S. Dist. LEXIS 77468 (D. Or. June 15, 2015) 26

Schwarz v. Universal Pictures Co., 85 F. Supp. 270 (S.D. Cal. 1945) 22, 23

Varsity Brands, Inc. v. Star Athletica, LLC,
799 F.3d 468 (6th Cir. 2015) ..... *passim*

Statutes

17 U.S.C. § 101 ..... passim

17 U.S.C. § 102(a)(5) 5, 13

17 U.S.C. § 102(b) ..... *passim*

Other Authorities

Brief of N.Y. Intell. Prop. L. Ass'n as *Amici Curiae, Star Athletica, LLC, Petitioner v. Varsity Brands Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc., Respondents,* No. 15-866. 19

Brief of Professors Christopher Buccafusco and Jeanne Fromer as *Amici Curiae, Star Athletica, LLC, Petitioner v. Varsity Brands Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc., Respondents,* No. 15-866 16

Brief of Public Knowledge, the Int'l Costumers Guild, Shapeways, Inc., and others as *Amici Curiae, Star Athletica, LLC, Petitioner v. Varsity Brands Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc.*, Respondents, No. 15-866 14

H.R. Rep. No. 94-1476 (1976) 20

Jane C. Ginsburg, *'Courts Have Twisted Themselves Into Knots': U.S. Copyright Protection for Applied Art* (Media Inst., June 29, 2016) 15

Leon R. Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457 (1951) 22

Leslie A. Kurtz, *Copyright: The Scenes A Faire Doctrine*, 41 FLA. L. REV. 79 (1989) 22

Sup. Ct. R. 37.2(a) 1

Sup. Ct. R. 37.6 1

INTEREST OF AMICUS CURIAE

Amicus curiae Intellectual Property Owners Association is a trade association representing companies and individuals in all industries and fields of technology that own or are interested in intellectual property rights.[1] IPO's membership includes roughly 200 companies and more than 12,000 individuals who are involved in the association either through their companies or as an inventor, author, executive, law firm, or attorney member.

Founded in 1972, IPO represents the interests of all owners of intellectual property. IPO regularly represents the interests of its members before Congress and the United States Patent and Trademark Office and has filed *amicus curiae* briefs in this Court and other courts on significant issues of intellectual property law.

---

[1] No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the amicus curiae or its counsel made a monetary contribution to its preparation or submission. Pursuant to Sup. Ct. R. 37.2(a), both parties to the case have consented to the blanket filing of *amici curiae* briefs in support of either party or neither party in separate docket entries dated May 10, 2016 and May 17, 2016, respectively.

The members of IPO's Board of Directors, which approved the filing of this brief, are listed in the Appendix.[2]

SUMMARY OF ARGUMENT

Petitioner, and some of the *amici* supporting it, conflate two distinct concepts and statutory guideposts of the 1976 Copyright Act (the "Act"): separability under the section 101 definition of pictorial, graphic and sculptural works, on the one hand; and originality under section 102(b), on the other hand. This case is about the former, and not the latter.

The Sixth Circuit made clear in its opinion that it was not addressing originality, and the district court did not address it either. *Varsity Brands, Inc. v. Star Athletica, LLC*, 799 F.3d 468, 476 (6th Cir. 2015) ("The only element of the validity of Varsity's copyright that is at issue in this appeal is whether Varsity's designs are protectable subject matter under the Copyright Act . . . . The parties do not address the originality of the designs, and therefore we do not address that issue now."); *id.* at 475 ("The district court did not address whether Varsity's designs were unoriginal and therefore unprotectable."). Accordingly, this Court should not address originality, or be tempted to import the concept of

---

[2] IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

originality into the distinct inquiry of what separability means and how it should be determined.

As to the separability inquiry, the Sixth Circuity did not create or exacerbate a circuit split. It merely synthesized language used in different circuits and by academics or commentators and articulated a series of questions that district courts should ask that are consistent with the approaches of all federal courts as well as the statutory definitions. *Id.* at 487. ("Not only is this approach consistent with the text of the Copyright Act, it is consistent with the holdings of our sibling circuits."). This Court should affirm.

As a threshold matter, the Court should consider the context of the dispute. Cheerleading in its competitive form is considered to be an official sport in many states. It combines elements of gymnastics and dance, with a unique brand of stunts and coordinated team movements. For that reason, uniforms are usually form fitting, but have many variations, such as sleeves vs. no sleeves, v-necks and crew necks, cut-outs, skirts or no-skirts, etc. Aside from the basic need to avoid loose fitting accessories, these are all design elements selected by each team. But this case is not even about those types of design choices – it is about an even more clearly non-utilitarian type of design – what is sewn on the uniforms to convey information about a team's logos and themes.

Hence, the pictures of the copyrighted designs at issue – refer to things like stripes,

chevrons, lines, curves, angles, diagonals, shapes, inverted V's, and various coloring choices. *Id.* at 471-74. These designs can be simple, one-color reproductions, or can be more elaborate, multi-color, adorned in glitter, and complex designs. None of these aspects serve any utility for the team's performance.

It may be a fair debate whether some or all of these design elements are original or unique, especially standing alone and outside of their total look and feel. But that question of originality is not before this Court – and should await fact finding at the trial court level. Instead, the only issue that this Court has to decide is whether those design elements provide utility to such a degree as to take them out of the definition of pictorial, graphic, and sculptural works. They do not.

IPO therefore supports affirmance of the Order below.

ARGUMENT

This Court granted *certiorari* in this case to address the question of "[w]hat is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act?"

A. Why This Case Is Important Beyond Cheerleading Uniforms

This case ostensibly is about the copyrightability of certain aspects of cheerleading

uniforms including stripes, chevrons, zigzags, and colors – in other words, it is about the design elements on the uniforms rather being about the shape of the uniforms themselves. Under 17 U.S.C. § 102(a)(5), "pictorial, graphic and sculptural" works are copyrightable. However, as described in more detail below, under the definition of "pictorial, graphic and sculptural" works in 17 U.S.C. § 101, "utilitarian aspects" of articles of manufacture are not copyrightable unless the design elements can be "identified separately from and are capable of existing independently of," the utilitarian functions.

In this case, the district court found that the design elements of the subject cheerleading uniforms were not copyrightable under that definition because, in its view, the aesthetic features of a cheerleading uniform "merged" with the functional purpose of the uniform. The Sixth Circuit reversed in a 2-1 decision, examining the approaches of other circuit courts, the Copyright Office, and legal commentators.

In reaching its conclusion reversing the district court, the Sixth Circuit essentially synthesized the various approaches of the court and the Copyright Office, and enumerated a totality of the circumstances, multi-factor type of test, in a similar fashion to other intellectual property tests recently approved by this Court, such as *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. ____, 134 S. Ct. 1749 (2014), and *Kirtsaeng v. John Wiley*. 136 S. Ct. 1979 (2016).

But this case is important well beyond the limited inquiry into the designs on cheerleading uniforms. The area of design is becoming of

increasing importance to industrialized America. It is important for companies to be able to distinguish their brands and the characteristics of their products by giving them distinctive designs, even where the underlying article might not itself be protectable by a patent or copyright. And thus the use of design elements – whether two dimensional or three dimensional – play an important role for companies seeking to differentiate themselves and their products in the marketplace. Recognizing that the use of such design features does not give them a property right over the underlying article; design still plays an important role in protecting a product's overall look and feel from unfair competition.

Accordingly, it is important to distinguish between what the "useful article" limitation is intended for, on the one hand, and what the "originality" limitation is intended for, on the other hand.

B. The Sixth Circuit Merely Synthesized the Law of All of the Circuits

The Sixth Circuit did not create a circuit split. Rather, it synthesized the law of other circuits while rejecting tests proposed by legal commentators that have not been approved by any other court. There was no circuit split before the Sixth Circuit's decision, although there were slightly different, but consistent, approaches to determining "conceptual separability." *Varsity Brands*, 799 F.3d at 485 (noting that circuit courts

have used "multiple of the above-listed approaches in the same case" when determining conceptual separability). Accordingly, although the Sixth Circuit noted nine different "approaches," that does not mean that there are nine separate standards or that the Sixth Circuit decision creates a tenth standard. In reality, all of the "approaches" are similar, if articulated in different ways.

Indeed, at base, as the Sixth Circuit recognized, there are two legitimate ways to determine separability – not 9 or 10. *Id.* at 481-82. Those two tests are described as "physical separability" and "conceptual separability." The Sixth Circuit correctly noted that no court has relied exclusively on physical-separability without also considering conceptual separability *Id.* at 483. It also correctly recognized that Congress, in enacting the "useful article" provision of the Act, relied on both types of separability in the House Report that is generally viewed as the best guide to the legislative history of the Copyright Act. *Id.*, citing H.R. Rep. No. 1476, 94th Cong., 2d Sess. at 47, 55 (1976).

Although the Sixth Circuit did address nine different approaches courts and commentators have taken in analyzing conceptual separability, *id.* at 484-85, it then explained that most circuits use more than one approach in the same case. *Id.* at 485. It then illustrated, for example, how courts in the Second and Fourth Circuit used a "hybrid" approach by slotting several of the accepted approaches into their analyses, using a

few different cases to illustrate the point. *Id.* at 486-86. The Sixth Circuit followed this approach by synthesizing the other Circuits' approaches into a five-part set of questions a court should answer in a contested case, described more fully below. By indicating where, within this five question analysis each of the "nine" other approaches may or may not fit, the Sixth Circuit noted that its approach was consistent with the "holdings of [its] sibling circuits." *Id.* at 487.

The court then analyzed the uniforms at issue and found that under the totality of circumstances test it adopted, the designs on the uniforms at issue met the separability test, and were thus protectable with respect to the sole question before it of whether the designs constituted copyrightable subject matter under section 101 of the Act. As noted above, it did not decide whether the designs at issue also met the originality test under section 102(b) – leaving that question for another day.

C. The Sixth Circuit's Synthesis of the Different Approaches Was Correct and Lays Out the Correct Test for Determining Whether the "Useful Article" Exception to Copyrightability Applies.

The Sixth Circuit performed an exhaustive review of cases from the various circuits, the Copyright Office, and legal commentaries. It synthesized the factors articulated by various decisions and set forth the following totality of the

circumstances multi-factor test in the form of five questions to be answered by the court:

> (1) Is the design a pictorial, graphic, or sculptural work?
>
> (2) If the design is a pictorial, graphic, or sculptural work, then is it a design of a useful article—"an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information"?
>
> (3) What are the utilitarian aspects of the useful article?
>
> (4) Can the viewer of the design identify "pictorial, graphic, or sculptural features" "separately from . . . the utilitarian aspects of the [useful] article[?]"
>
> (5) Can "the pictorial, graphic, or sculptural features" of the design of the useful article "exist[] independently of[] the utilitarian aspects of the [useful] article[?]"

Varsity Brands, 799 F.3d at 487-88.

Each question derives from prior cases in a variety of circuits and is consistent with all of them without creating a circuit split. The Sixth Circuit thus merely took the various articulated

approaches and harmonized them into steps of the analysis. This is just another way of articulating multiple factors that district courts can consider in their discretion.

A flexible 'totality of the circumstances' balancing test is consistent with this Court's recent intellectual property decisions. In cases like *Octane Fitness* and *Kirtsaeng*, this Court rejected subjective tests that had been applied by the various courts of appeal. In doing so, it deemed those tests "too restrictive." *Octane Fitness*, 134 S. Ct. at 1758; *see Kirtsaeng*, 136 S. Ct. at 1987-88. Instead, the Court mandated that where Congress had left discretion to the district courts, that those lower court should be given guidance with factors to consider, but should exercise their discretion on a "case-by-case" basis, considering "the totality of the circumstances." *Octane Fitness*, at 1756. The Sixth Circuit's approach is therefore a permissible and correct methodology supported by section 101 of the Copyright Act.

It is important to note that the question presented, as framed by Petitioner, in some ways puts the cart before the horse and seeks to define the rule of what is protectable through the lens of the exception to protection rather than determining protectability first. This is a subtle but necessary distinction. By asking "what is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act," the question overlooks the

threshold question of when the "useful article" exception even comes into play.

Rather, the first question that needs to be asked, as the Sixth Circuit correctly determined, is whether a work is a pictorial, graphic, or sculptural work in the first place, because that is the only type of work to which the exception applies. The applicable definition is stated as follows:

> "*Pictorial, graphic, and sculptural works*" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. *Such works* shall include works of artistic craftsmanship *insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article*, as defined in this section, *shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.*

17 U.S.C. § 101 (emphasis added).

Accordingly, only after deciding whether the work is protectable as a pictorial, graphic, or sculptural work, is it necessary to determine whether (a) the copyright owner is seeking to protect the mechanical or utilitarian aspect of the work; and then (b) whether the design elements are separable and can exist independently. In order to make that assessment, Congress added a definition of what a "useful article" is:

> A "useful article" is an article *having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information*. An article that is normally a part of a useful article is considered a "useful article."

17 U.S.C. § 101 (emphasis added).

Petitioner cleverly thus starts its brief with the following, incorrect assumption, purporting to cite this definition: "A useful article– such as a chair, a dress, or a uniform– cannot be copyrighted." Pet'r's Br. 6. But the Act does not say this at all. Rather, it just says that if something is a pictorial, graphic, or sculptural work, protectable under section 102(a)(5), then any intrinsic utilitarian functions of such a work are not a part of what is protectable by copyright. It does not say that protection is never available to aspects of a chair, a dress or a uniform, and that is a huge difference.

When the statutory scheme is correctly followed, after it is determined whether a work is, in fact, a two- or three-dimensional pictorial, graphic, or sculptural work, it then needs to determine whether the work also has an "intrinsic utilitarian function" that is "not merely to portray the appearance of the article or to convey information." Again, the Sixth Circuit thus got the second question right.

If it does not have such a utilitarian function, the inquiry is over and the exception simply does not apply. But if it does have such a function, then the next question, again correctly framed by the Sixth Circuit, comes into play: "What are the utilitarian aspects?"

And once those aspects are determined, only then do the last two questions need to be asked, in order to determine protectability from the standpoint of the "subject matter" inquiry, which come directly from the statutory language quoted above:

> (4) Can the viewer of the design identify "pictorial, graphic, or sculptural features" "*separately from* . . . the utilitarian aspects of the [useful] article[?]"
>
> (5) Can "the pictorial, graphic, or sculptural features" of the design of the useful article "*exist[] independently* of[] the utilitarian aspects of the [useful] article[?]"

Varsity Brands, 799 F.3d at 488. (emphasis added).

In our example here, the form fit and stitching of the outfits to enable physical activity is the intrinsic utilitarian function– not the designs portrayed *on* the outfits.[3] *See also* Jane C. Ginsburg, *'Courts Have Twisted Themselves Into Knots': U.S. Copyright Protection for Applied Art*, (Media Inst., June 29, 2016) ("[T]he court could have recognized that the design elements at issue – the fabric designs representing team insignia – were not useful articles in the first place. . . . [There is a] difference between the design element (insignia) and the useful article (the garment)."). The outfits could be a plain single color and still achieve their function as an athletic uniform; they do not need stripes, chevrons, inverted "V's" and other design elements to serve their utilitarian purpose. Rather, the design elements do exactly what is permissible under the statutory definition: they convey information about the team. Accordingly, the Sixth Circuit got both the

---

[3] Contrary to the *amicus* brief filed by Public Knowledge, the International Costumers Guild, Shapeways, Inc, and others (Brief of Public Knowledge, et al. ("Public Knowledge Br.") as *Amici Curiae, Star Athletica, LLC, Petitioner v. Varsity Brands Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc., Respondents*, No. 15-866.), the "style of clothing" is definitively not at issue, nor is the right to express oneself in protest or to participate in a political statement. *See* Public Knowledge Br. 19-22.

test and the result right. *See* Ginsburg, *supra* ("[T]he Sixth Circuit effectively applied the statutory standards," but noted that it could have made even "shorter work of its analysis" because the status of the designs as pictorial, graphic, or sculptural works "did not require assessing the characteristics of the uniforms.").

D. The Sixth Circuit Correctly Rejected Subjective Criteria Proposed by Academic Commentaries.

The Sixth Circuit did reject some of the approaches proposed by scholars and treatises that require subjectivity in their application with good reason. The four "approaches" rejected included those coined by the Sixth Circuit as: (1) the "Design-Process Approach," (*i.e.*, why the designer chose the design); (2) the "Subjective-Objective" test (*i.e.*, reviewing the designer's subjective process first); (3) the "Party Approach" (*i.e.*, requiring abandonment of the physical and conceptual separability distinction); and (4) the "Likelihood-of-Marketability Approach" (*i.e.*, requiring conjecture based on marketability of the aesthetic qualities).

Each of these approaches requires a subjective determination as a matter of law, which is not supported by the definitions in the statute.[4] As Justice Holmes cautioned long ago,

---

[4] Similarly, the main argument made by Professors Christopher Buccafusco and Jeanne Fromer as

"it would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). *Bleistein* involved advertisements for the circus; the import though is clear: whether creative works are for the purpose of commerce (such as industrial designs) or art, the question of copyrightability is the same.

Last term, this Court echoed that sentiment about not using subjective tests in intellectual property matters where the statute does not have a subjective element. In rejecting a proposal that fee-shifting in Copyright cases be guided by whether the lawsuit resolved an important and close legal issue and thus meaningfully clarified copyright law, this Court in *Kirtsaeng* held that using such a subjective factor would not be administrable, because a judge might not know at the conclusion of a suit whether a newly decided issue will have broad legal significance. *Kirtsaeng*, 136 S. Ct. at 1987-88. Similarly, in *Octane Fitness*, this Court held that requiring "subjective" bad faith to award fees in patent cases

---

amicus in support of Petitioner that fashion designs serve a dual purpose because the design of a garment is intended to make the wearer look attractive, Brief of Professors Christopher Buccafusco and Jeanne Fromer as *Amici Curiae* 8, 10, 18-24, is too subjective to be a part of the analysis; moreover, this case is not about garment shape.

was overly restrictive. *Octane Fitness*, 134 S. Ct. at 1755.

There is no language in the definitions of section 101 requiring or permitting a subjective analysis. Rather, the inquiry into whether a pictorial, graphic, or sculptural work is disqualified for protection because it is a "useful article" calls for the application of objective criteria, such as those articulated by the Sixth Circuit.

E. "Originality" Is Not Part of the "Separability" Analysis and Section 102(b) Is Not Before the Court

To the extent that Petitioner urges this Court to take up the question of originality and import artistic merit into the test for separability, it is wrong. (*See* Pet'r's. Br. 39 ("copyrightability turns on whether the feature is purely artistic"); *id.* at 11-12 ("[T]his case is the opportunity to . . ensure that the stripes, chevrons, and color blocks of a cheerleading-uniform design do not receive a century of copyright protection.")). The Court granted *certiorari* limited to protectability under section 101, not originality under section 102(b).

Accordingly, IPO urges that the decision of the Sixth Circuit be affirmed in a narrow way that does not implicate section 102(b) and that does not go farther than necessary.

This case is not about the originality of the stripes and chevrons on the uniforms or the scope of protection that they should receive in an

infringement analysis. That is the proper focus of an inquiry into section 102(b) of the Copyright Act, which provides that:

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 102(b).

This is commonly understood to be the enforcement mechanism of the "originality" requirement in copyright law, and is also sometime referred to as the "idea/expression dichotomy." Because copyright protection extends only to the expression of an idea, and not the idea itself, *Mazer v. Stein*, 347 U.S. 201, 217 (1954), Congress codified this distinction in section 102(b) of the Act. *See also Golan v. Holder*, 132 S. Ct. 873, 890 (2012) ("[T]he idea/expression dichotomy is codified at 17 U.S.C. § 102(b).").

It bears noting that two *amicus* briefs filed at the petition stage in support of Petitioner and one filed in support after *certiorari* was granted are more concerned with the idea/expression dichotomy under section 102(b) than they are with the separability test under section 101. In a brief filed by Formlabs, the argument is proffered that the additive manufacturing (i.e., 3D printing) industry needs a single predictable test for "conceptual separability." But the brief, as well as

an *amicus* brief filed by Public Knowledge in support of Petitioner and one filed by the Royal Manticoran Navy Official Honor Harrington Fan Association, does not add any useful discussion of the supposed circuit split. *Cf. also Amicus* Brief of N.Y. Intell. Prop. L. Ass'n in Support of Neither Party 28, enumerated item (2) (proposing that originality and fixation be part of the separability test). Instead, what these *amicus* briefs seem to be concerned about all relate to what this case is explicitly NOT about: whether chevrons, stripes, and the like, are original enough to warrant copyright protection and whether the particular designs at issue are sufficiently distinctive to preclude others from using them.

But neither originality nor the application of section 102(b) is before this Court. Section 102(b) jurisprudence has developed in the courts through doctrines that limit the scope of protection for common elements, such as "merger," "scenes a faire," and the "public domain" doctrine, in order to enforce the prohibitions and contours of section 102(b), and to ensure that only the original aspects of works are protected from infringement.

These doctrines go all the way back to *Baker v. Selden*, 101 U.S. 99, 103-04 (1879), where this Court stated that methods and diagrams which are necessary incidents to an art "for the purpose of practical application. . [are] open and free to the use of the public."

In enacting section 102(b), Congress expressly stated that the purpose of the section is

"to restate, in the context of the new single federal system of copyright, that the basic dichotomy between expression and idea remains unchanged." H.R. Rep. No. 94-1476, at 57. Because this dichotomy was understood from the earliest days of copyright protection, a combination of doctrines were designed by courts to separate out unprotected elements of a work before determining whether illicit or permissible copying has occurred. Because only the copying of protected elements is illegal, unprotected elements may be freely copied. The doctrines of: (1) merger; (2) scenes a faire; (3) the sanctity of the public domain; and (4) "thin" copyright, have developed in order to protect the public from excessive monopolization and to guard against impingement on the Copyright Clause's purpose of promoting the arts. But none of those issues are ripe for this Court's decision at this stage of the case, and it should not import those concerns into its analysis of the separability issue before it.

Lower courts have no problem in dissecting the components of a copyrighted work in order to determine whether the expression was "dictated by considerations of efficiency, so as to be necessarily incidental to th[e] idea; required by factors external to the [work] itself; or taken from the public domain." *Comput. Assocs., Inc. v. Altai*, 982 F.2d 693, 706-07 (2d Cir. 1992); *see also Oracle Am., Inc. v. Google, Inc.*, 750 F.3d 1339, 1354-55 (Fed. Cir. 2014). In such instances, protection afforded to a copyright plaintiff do not bar copying of the filtered out elements.

Where expression embodying the ideas of an author is inseparable from the idea itself, the doctrine of merger limits the scope of protection of a work severely. Especially in cases where "there is essentially only one way to express an idea, the idea and its expression are inseparable, and copyright is no bar to copying that expression." *Altai*, 982 F.2d at 707-08 (citations omitted). But that is a different kind of "inseparability" than the "separability" at issue in a section 101 analysis and the two should not be confused. Petitioner tries to invite this mistake, and the Court should not address the application of the merger doctrine *sua sponte*.

The scenes a faire doctrine is another limitation on protection that lower courts can use to narrow protection where warranted. In the 1940's Judge Leon Yankwich of the Southern District of California introduced the doctrine of "scenes a faire" to American copyright law. *See generally* Leslie A. Kurtz, *Copyright: The Scenes A Faire Doctrine*, 41 FLA. L. REV. 79 (1989); Leon R. Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457 (1951) (discussing Georges Polti's influential book, The Thirty-Six Dramatic Situations (1940)). Stated simply, this doctrine prevents copyright owners from monopolizing "scenes" which "must be done," given the setting and surrounding circumstances. In 1942, in *Cain v. Universal Pictures* Co., 47 F. Supp. 1013, 1017 (S.D. Cal. 1942), and again in 1945 in *Schwarz v. Universal Pictures* Co., 85 F. Supp. 270, 278 (S.D. Cal.

1945), Judge Yankwich gave detailed illustrations.

In *Cain*, holding that small, incidental details were often not protectable, Judge Yankwich stated:

> The other small details, on which stress is laid, such as the playing of the piano, the prayer, the hunger motive, as it is called, are inherent in the situation itself. . . Once having placed two persons in a church during a big storm, it was inevitable that incidents like these and others which are necessarily associated with such a situation should force themselves upon the writer.

Cain, 47 F. Supp. at 1017. And, in *Schwarz*, Judge Yankwich pointed to an old silent film in which an actor "came in, spilled some red ink; then took a handkerchief and wiped the ink off his hand with it. That was the beginning. Ultimately there had to be a scene explaining the red spot." 85 F. Supp. at 275.

Thus, the scenes a faire doctrine prevents the protection of stock or standard devices. General patterns, character prototypes, and themes are not protectable. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930); *see also Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971) (expression in the form of bee pins could be copied because of the

limited number of ways of expressing the idea of a bee pin, and to allow copyright protection would give the plaintiff a monopoly on the idea); *Dellar v. Samuel Goldwyn*, 150 F.2d 612 (2d Cir. 1945) (*per curiam*) (theme, plot, or ideas may be freely borrowed).

Next, to the extent a work is taken from the public domain, "such material is free for the taking." *Comput. Assocs.*, 982 F.2d at 710. An author cannot, "by originating a new arrangement and form of expression or particular ideas or conceptions . . . withdraw these ideas or conceptions from the stock of materials to be used by other authors." *Eichel v. Marcin*, 241 F. 404 (S.D.N.Y. 1913).

And, although the standard for originality is normally quite low, in the case of works which rely on underlying works for their existence, the standard is much higher. Thus, in *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976), the well-known "Uncle Sam Bank" case, the Second Circuit held that trivial variations in the translation of a work to a different medium do not make the new work protectable. *Id.* at 491. Particularly important to the court was that the changes in the work were more driven by the medium of the form than by originality on the part of the author. *Id.* at 488-49. The court held that "absent a genuine difference between the underlying work and the copy of it for which protection is sought, the public interest in promoting progress in the arts,

indeed, the constitutional demand, could hardly be served." *Id.* at 492.

Furthermore, in *Feist Publ'ns, Inc. v. Rural Tel. Serv.* Co., 499 U.S. 340 (1991), the Supreme Court explicitly recognized the concept of the "thin" copyright. Under *Feist*, the owner of a thinly protected work can only prevent against extensive verbatim copying, and cannot protect elements of its work which are "mechanical and routine," "practically inevitable," "age old practice," "firmly rooted in tradition," "entirely typical," "garden variety," "obvious," and where there is a "lack of significant choice." *Id.* at 362-63. *Feist's* language regarding the filtering out of what is not original and providing only thin protection against virtually identical works is equally applicable to graphic, pictorial, and sculptural works, and courts are routinely able to follow this guidance. *See, e.g.*, *Hoberman Designs, Inc. v. Gloworks Imps., Inc.*, No. 14-6743, 2015 U.S. Dist. LEXIS 176117 (C.D. Cal. Nov. 3, 2015) (granting defendant's motion for summary judgment after finding that defendant's sale of expanding and contracting geometric plastic toys did not infringe plaintiff's design where plaintiff's design comprised of several mechanical or utilitarian elements and where those elements that were protectable in plaintiff's toys differed from defendant's toys); *Folkens v. Wyland*, No. 14-2197, 2016 U.S. Dist. LEXIS 47373 (E.D. Cal. Apr. 6, 2016) (granting summary judgment in favor of defendant after finding that the only similarities between the plaintiff's and defendant's works consisted of unprotectable elements such as

natural positioning and physiology of dolphins); *Alpi Int'l, Ltd. v. Anga Supply, LLC*, 118 F. Supp. 3d 1172 (N.D. Cal. 2015) (partially denying defendant's motion for summary judgment despite fact that plaintiff was only entitled to "thin" copyright protection because defendant's designs were "extraordinarily similar" to those of plaintiff and therefore infringing); *Rentmeester v. Nike, Inc.*, No. 15-113, 2015 U.S. Dist. LEXIS 77468 (D. Or. June 15, 2015) (dismissing case after finding that plaintiff photographer's photo of Michael Jordan was entitled only to narrow copyright protections and finding that defendant Nike's work was not similar enough for a finding of infringement because works would have had to be virtually identical copies). Thus, when an author selects and arranges a number of unprotectable elements, it may protect the work against only a limited number of nearly verbatim uses.

Here, the Sixth Circuit made clear that it was not asked to address originality or the scope of protection under section 102(b), and it made clear that it was not reviewing those issues at this stage of the case. *Varsity Brands*, 799 F.3d at 476.

Accordingly, there should be no concern here that an affirmance of the Sixth Circuit's approach will lead inexorably to the taking of unoriginal design ideas out of the public domain, which is what Petitioner and several *amici* appear to be most concerned about. That question is for

a later stage in this case on a more developed record, but is not before the Court now.[5]

CONCLUSION

There is no irreconcilable circuit split concerning how the definitions under section 101 should be followed for determining when a pictorial, graphic, and sculptural work is separable from the intrinsic utilitarian aspects of a useful article that the design elements might happen to be printed on. The Sixth Circuit's harmonization of different approaches to "separability" by placing each of many factors considered by other courts and the Copyright Office into a five question framework makes inherent good sense, and makes use of the experience of different circuits in defining physical and conceptual separability by providing guidance for district courts to take into account the totality of the circumstances in an objective manner without cabining their discretion.

Section 102(b), originality concerns, and fair use issues raised by Petitioner or its supporting *amici* are not before the Court at this time, and should not be decided here because there is no

---

[5] Nor should the Court take on fair use at this stage of this case, as urged in the Royal Manticoran Navy Official Honor Harrington Fan Association *amicus* brief. It was not before the Sixth Circuit and is not before this Court.

record on which to decide those issues. Moreover, issues of originality or the idea/expression dichotomy should not be imported into the test for separability under section 101, but should remain separate inquiries about the scope of protection for a given work.

September 19, 2016

Respectfully submitted,

INTELLECTUAL PROPERTY OWNERS ASSOCIATION
KEVIN H. RHODES, *President*
STEVEN W. MILLER, *Chair*
Amicus Brief Committee
1051 M Street, NW, Suite 1150
Washington, DC 20005
(202) 507-4500

DAVID LEICHTMAN
Counsel of Record
SHERLI FURST
ROBINS KAPLAN L
601 Lexington Avenue
New York, NY 10022
(212) 980-7400
dleichtman@robinskaplan.com
sfurst@robinskaplan.com

Counsel for Amicus Curiae

APPENDIX[1]

Members of the Board of Directors
Intellectual Property Owners Association

Scott Barker
Micron
Technology, Inc.

Stephen W. Bauer
Medtronic, Inc.

Edward Blocker
Koninklijke Philips
N.V.

Amelia Buharin
Intellectual
Ventures, LLC

Tina M. Chappell
Intel Corp.

Karen Cochran
Shell International
B.V.

John D. Conway
Sanofi

William J. Coughlin
Ford Global
Technologies LLC

Anthony DiBartolomeo
SAP AG

Daniel Enebo
Cargill, Inc.

Barbara A. Fisher
Lockheed Martin

Louis Foreman
Enventys

Scott M. Frank
AT&T

Darryl P. Frickey
Dow Chemical Co.

Gary C. Ganzi
Evoqua Water
Technologies, LLC

Henry Hadad
Bristol-Myers Squibb
Co.

Heath Hoglund
Dolby Laboratories

[1]IPO procedures require approval of positions in briefs by a two-thirds majority of directors present and voting.

Carl B. Horton
General Electric Co.

Philip S. Johnson
Johnson & Johnson

Thomas R. Kingsbury
Bridgestone
Americas, Inc.

Charles M. Kinzig
GlaxoSmithKline

William Krovatin
Merck & Co., Inc.

Dan Lang
Cisco Systems, Inc.

Mark W Lauroesch
Intellectual Property
Owners Association

Allen Lo
Google Inc.

Timothy Loomis
Qualcomm, Inc.

Thomas P. McBride
Monsanto Co.

Elizabeth McCarthy
Avaya, Inc.

Todd Messal
Boston Scientific Co.

Steven W. Miller
Procter & Gamble
Co.

Micky Minhas
Microsoft Corp.

Rimma Mitelman
Unilever

Douglas K. Norman
Eli Lilly and Co.

Richard F. Phillips
Exxon Mobil Corp.

Dana Rao
Adobe Systems Inc.

Kevin H. Rhodes
3M Innovative
Properties Co.

Curtis Rose
Hewlett-Packard
Enterprise

Matthew Sarboraria
Oracle USA Inc.

Manny Schecter
IBM Corp.

Steven J. Shapiro
Pitney Bowes Inc.

Jessica Sinnott
DuPont

Dennis C. Skarvan
Caterpillar Inc.

Daniel J. Staudt
Siemens Corp.

Brian Suffredini
United Technologies
Corp.

James J. Trussell
BP America, Inc.

Roy Waldron
Pfizer, Inc.

BJ Watrous
Apple Inc.

Stuart L. Watt
Amgen, Inc.

Steven Wildfeuer
RELX Group

Michael Young
Roche, Inc.